

3733



Docket No. 269/106
2024730- 7013343001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Robert M. Abrams, et al.

Serial No.: 10/038,730

Filed: January 2, 2002

For: LIQUID BASED VASO-OCCLUSIVE
COMPOSITIONS

Group Art Unit: 3733

Confirmation No.: 1632

Examiner: Ram R. Shukla

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RESPONSE TO RESTRICTION REQUIREMENT TRANSMITTAL

M/S: Non Fee
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Transmitted herewith is a Response to Restriction/Election Requirement (4 pages) for the above-identified application.

Respectfully submitted,

BINGHAM McCUTCHEN LLP

Dated: 11/5/03

By: David W. Maher
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RESPONSE TO ELECTION/RESTRICTION REQUIREMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This is a response to the Election/Restriction Requirement mailed October 17, 2003, for the above-referenced application. Reconsideration is respectfully requested.

Response

The Restriction Requirement stated that there were distinct inventions and required Applicant to elect one invention for prosecution on the merits. The claims were restricted into the following groups:

- I. Claims 32-37, 40, 41, 43, 44, 46, and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is a protein or peptide, classified in class 514, subclass 2.
- II. Claims 32-37, 40, 41, 42, 44, 45, and 47-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is nucleic acid, classified in class 514, subclass 44.
- III. Claims 32-37, 40, 41 and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is a phospholipid, classified in class 514, subclass 44.
- IV. Claims 32-37, 40, 41, 44 and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is any polymer, classified in class 514, subclass 44.
- V. Claims 32-37, 40, 41, 44 and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is any compound, classified in class 514, subclass 1.
- VI. Claims 32-37, 40, 41, 44 and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is a DSN compacting agent, classified in class 514, subclass 1.
- VII. Claims 32-37, 40, 41, 44 and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is a virus, classified in class 424, subclass 93.1.
- VIII (listed as IX). Claims 32-37, 40, 41, 43, 44, 46, and 53-60, drawn to a precursor composition comprising polymer forming biodegradable material and a biologically active component that is a liposome, classified in class 424, subclass 450.

The Restriction Requirement asserted that the inventions of the restricted Groups were unrelated, classified in different class and subclass, and that the compositions are not species of a genus.

Applicants respectfully request reconsideration of the restriction between groups I-V.

All these groups fall within the same class (514), and a search in that class based on the polymer forming biodegradable material recited in the claims could be performed without a serious burden. Group V is listed as a combination of such a biodegradable material with “any compound.” The language “any compound” is generic to the more specific compounds of Groups I (protein or peptide), II (nucleic acid), III (phospholipid), and IV (any polymer). Therefore examination of Groups I-V based on the generic nature of the “any compound” biologically active component of Group V is requested.

Alternatively, the “any polymer” component of the claims of Group IV is generic to the polymeric proteins or peptides of Group I and polymeric nucleic acids of Group II. Should restriction of Groups I-V be maintained, Applicants request examination of Groups IV, II and I based on the generic nature of the “any polymer” component recited in Group IV.

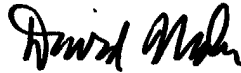
Applicant provisionally elects the invention of Group IV (Claims 32-37, 40, 41, 44, 53-60), classified as a precursor composition comprising polymer forming biodegradable material and a biologically active component that is any polymer, classified in class 514, subclass 44. Applicant requests consideration of claims 38-39 with Group IV or the alternative groupings proposed above, as it appears that claims 38-39 were inadvertently not addressed in the Restriction Requirement and should have been included in each group; these claims are dependent and do not fall exclusively within any of the recited groups.

Applicant elects the species polyglycolic acid for claim 35. Applicant elects the species polyhydroxybutyrate for claim 36. Applicant provisionally elects the species fibronectin of claim 43 should reconsideration be granted and Group I and/or claim 43 be examined.

An action on the merit of this elected species and a Notice of Allowance thereof are respectfully requested. If the Examiner has any questions concerning this Response, the Examiner is respectfully requested to telephone Applicants' attorney at the following telephone number (650) 849-4908.

Respectfully submitted,
BINGHAM McCUTCHEN LLP

Dated: 11/5/03

By: 
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